



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,322	02/26/2004	Shoichi Ando	12052.33USD1	9419
7590 03/24/2009 Hamre, Schumann, Mueller & Larson, P.C. P.O. Box 2902-0902 Minneapolis, MN 55402				
EXAMINER				
ZHU, WEIPING				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
03/24/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/789,322

Applicant(s)

ANDO ET AL.

Examiner

WEIPING ZHU

Art Unit

1793

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 3-9 and 19.
Claim(s) withdrawn from consideration: 10-17, 21 and 22.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: of the reasons as stated in the final rejection.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/George Wyszomierski/
Primary Examiner
Art Unit 1793

/Weiping Zhu/
Examiner, Art Unit 1793

The proposed amendment to claim 19 adds limitations in the microstructures of the steel, which have already been addressed in the rejections of claims 1 and 5 as stated in the final Office action dated November 7, 2008. Therefore, the previous rejection of claim 19 under 35 U.S.C. 103(a) as stated in the final rejection dated November 7, 2008 has been maintained.

The applicant's arguments filed on March 6, 2009 have been fully considered but they are not persuasive.

First, the applicant argues that the stretching step of Tomioka et al. ('560) is for the purpose of obtaining a fine grain sorbite structure for continuous cold forging; there is no motivation to combine the teachings of Tomioka et al. ('560) with those of JP ('246); and there is no evidence that the drawing ratio is a result effective variable. In response, the examiner notes that the process as disclosed by Tomioka et al. ('560) depends on a tempering step not a drawing step to obtain a fine grain sorbite structure (col. 3, lines 26-43); the motivation to combine Tomioka et al. ('560) with those of JP ('246) is stated clearly in the Office action dated April 16, 2008 as that it would have been obvious to one of ordinary skill in the art to have applied a drawing ratio of less than 20% as disclosed by Tomioka et al. ('560) in the process of JP ('246) in order to achieve the desired diameter and tensile strength of the wire as disclosed by Tomioka et al. ('560) (col. 7, lines 62-65); and the disclosure of Tomioka et al. ('560) that the tempered wire is stretched by an amount less than 20% so as to adjust its diameter and tensile strength (col. 7, lines 62-65) clearly indicates that the drawing ratio is a result-effective variable.

Second, the applicant argues that none of the references recited by the examiner teaches the claimed microstructure and the application of In re Best, 195 USPQ 430, 433 (CCPA 1977) is improper because Tomioka et al. ('560) teaches a different microstructure. In response, the examiner notes that Tomioka et al. ('560) is relied upon for the teaching of the drawing ratio. The rejections of the claimed microstructure features based on the teachings of JP ('246) in view of Tomioka et al. ('560) and further in view of Bach et al. ('166) is proper and maintained. Each reference does not have to teach all the claim limitations as long as the references are combined with proper motivations.

Third, the applicant argues that Tomioka et al. ('560) requires a tempering temperature not in excess of 700 C. In response, the examiner notes the ground of rejection of the claimed annealing schedules relies on the teaching of JP ('656) rather than that of Tomioka et al. ('560) as stated in the final Office action dated November 7, 2008. It is further noted the tempering of Tomioka et al. ('560) is different from the annealing of JP ('656) and serves a very different purpose. Therefore, the tempering temperature of Tomioka et al. ('560) does not have to be the same as the annealing temperature as disclosed by JP ('656).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.